

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles Eldering et al.

Conf. No.: 8882 : Group Art Unit: 2623
Appln. No.: 09/712,790 : Examiner: SHELEHEDA, James R.
Filing Date: 14 NOVEMBER 2000 : Attorney Docket No.: T721-10
Title: Queue Based Advertisement Scheduling and Sales

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Applicant(s) request(s) review of the Final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
- ☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.
- ☒ Extension of Time to and including January 27, 2009 is filed herewith.

Date: 1/27/09

Andrew W. Spicer
Andrew W. Spicer, Esquire
Reg. No. 57,420
Carlineo, Spicer & Kee, LLC
2003 South Easton Road, Suite 208
Doylestown, PA 18901
(267) 880-1720

Customer Number 81712

STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Presently, claims 1-10, 12-18, 60, 62 – 65 and 68 – 105 are pending in the application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Non-Final Office Action dated December 28, 2007 ("Non-Final Rejection") and the Examiner's Final Office Action dated August 27, 2008 ("Final Rejection").

Discussion of the prior art references and the pending claims may be found in Applicants' Amendment Accompanying RCE, filed September 22, 2006, Applicants' Request for Reconsideration, filed May 29, 2007, Applicants' Amendment Accompanying RCE, filed October 26, 2007 ("RCE"), and Applicants' Amendment, filed June 30, 2008 ("Amendment"), which are incorporated herein by reference. In addition, two Declarations under 37 C.F.R. §1.132 of Charles A. Eldering and Bernardo Paratore, respectively, were submitted with the RCE.

No Prima Facie Obviousness

As detailed in Applicants' previous papers, the Examiner has not established a *prima facie* case of obviousness in rejecting claims 1, 2, 7, 8, 10, 12 – 18, 60, 62 – 65, 68 – 105 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,698,020 to Zigmond *et al.* ("Zigmond") in view of U.S. Patent Publication No. 2003/0200128 to Doherty ("Doherty"), and claims 3 – 6 and 9 as unpatentable over Zigmond and Doherty in further view of U.S. Patent No. 6,505,169 to Bhagavath *et al.* ("Bhagavath").

1. The Proposed Combination Does Not Teach or Suggest All Claim Elements

When making a rejection under 35 U.S.C. § 103, the prior art references, when combined, must teach or suggest all of the claim limitations. *See* MPEP 2143.03.

Applicants disagree with the Examiner's assertion that Applicants have argued against the obviousness rejection by attacking the references individually. Final Rejection at 5. Rather, Applicants have repeatedly pointed out that the references do not teach or suggest the features as contended by the Examiner, and, therefore, cannot possibly teach or suggest such features when combined. *See* Amendment at 18.

Zigmond Does Not Teach or Suggest “selling specific slots”

Applicants respectfully disagree with the Examiner’s assertion that Zigmond teaches “selling specific queue slots” or “queue locations.” *See* Final Office Action at 9. The Examiner argues that an advertiser’s ability to make a selection relative to another ad, “qualifies as a ‘specific’ spot as it is an explicit declaration on the desired display.” Final Office Action at 2.

As explained in Applicants’ Amendment, it is Zigmond’s system – not the advertisers – that determines which ad is selected for display. *See* Amendment at 16 – 17. In Zigmond, there is no guarantee that an advertiser’s ad will be selected based on an advertiser submitting certain criteria (e.g., that its ad be displayed after (or near) a competitor’s ad). Furthermore, Zigmond’s disclosure does not mean that the advertiser in Zigmond *purchases a specific slot or location*. Rather, the advertiser merely purchases the ability to display an ad in general.

Moreover, it would be impossible for an advertiser to purchase a *specific slot* in Zigmond, since Zigmond is premised on the application of ad selection criteria to determine which advertisement is displayed relative to the content of the previous advertisement. *See* Amendment at 16 – 17. Again, it is Zigmond’s system, and not the advertiser, that makes the determination as to which advertisement is inserted at which particular point. Therefore, the ability to purchase specific slots for advertisements is directly contrary to the teachings of Zigmond’s ad insertion device and use of ad selection criteria. At page 3 of the Final Rejection the Examiner argues that Zigmond necessarily designates a particular ad for a particular slot because Zigmond, “is limited to the particular ads and ad criteria that are available.” This is misleading and disingenuous. Into which slot a particular ad may be placed as a result of ad selection criteria is irrelevant with respect to the current claims. The fact remains that Zigmond’s system does not permit the selection or sale of a “specific queue slot”.

Zigmond Does Not Teach or Suggest “selling specific slots based on a repetition rate”

Zigmond also does not teach or suggest the concept of “...identifying a repetition rate specified by an advertiser, ...and selling specific queue slots to the advertiser based at least partially on the specified repetition rate...,” as recited in independent claim 60. *See* Amendment at 16. The Examiner now appears to rely on paragraph 50 and Fig. 3D of Doherty for this feature. *See* Final Office Action at 3, 25 – 27. However, the cited “ramp profile” in Doherty does not have any

relationship to “selling specific queue slots to the advertiser based...on the specified repetition rate.” Zigmond and Doherty are silent with respect to selling specific queue slots based on a repetition rate that represents spacing between slots in the queue.

Doherty Does Not Teach Selling Specific Slots in a Queue

The Examiner suggests that, because Doherty teaches a queue or an ordered list of advertisements and a priority profile to determine which ad to display at any given time, Doherty therefore teaches that locations in Doherty’s queue are sold to advertisers. Final Office Action at 4. However, Applicants have explained that Doherty merely teaches adjusting one’s “priority profile” by altering the “advertising premium”. See Amendment at 17 – 18. Thus, Doherty does not teach or suggest selling specific queue slots to advertisers.

Combination Does not Teach All Elements

For at least the reasons set forth above and previously discussed, the combination of Zigmond and Doherty does not teach or suggest insertion of ads, “***in accordance with the ordered list.***” See Amendment at 18. If Doherty were to be combined with Zigmond as proposed by the Examiner, the alleged “queue” in Zigmond as modified by Doherty would not have the ability to insert ads “in accordance with the ordered list” because the queue (i.e., the ordered list) would not have been created yet. In the proposed combination, it would be impossible for the “sold specific queue slots” to determine the ordered list (and thus the order of insertion) since the combination of Zigmond and Doherty necessarily requires waiting until after the previous ad to determine the next ad to be inserted.

Additionally, the combination does not teach or suggest “***selling specific queue slots.***” See Amendment at 19. None of the applied references teaches the concept of selling specific slots generally or in a queue. Thus, the combination of Zigmond and Doherty also lacks at least this feature. Furthermore, the Examiner appears to have ignored the Eldering and Paratore Declarations that draw well-founded conclusions to this effect. See RCE at 15, 19 and Amendment at 19. Accordingly, Applicants respectfully submit that the combination of Zigmond and Doherty does not result in all features of the claims.

Claimed Subject Matter is Non-Obvious

Even if Doherty's schedule is incorporated into Zigmond's system, **it cannot be inferred from such a combination – nor would it have been obvious to one skilled in the art – that specific slots would be sold at all, let alone specific slots in the included schedule or queue.** The Examiner is not entitled to assume that there would be any modification of Zigmond's ad selection system to permit the sale of specific slots simply because Doherty's schedule is now resident in Zigmond's system. *See* Amendment at 19. In addition, the Eldering Declaration explains that the claimed subject matter is not disclosed in the prior art and would not have been obvious to those skilled in the art, in part because *the claimed subject matter resulted from long felt need*. *See* MPEP §716.04; Amendment at 19. Accordingly, Applicants respectfully submit that the independent claims are non-obvious over the proposed combination.

2. Combination of Zigmond and Doherty is Improper

In *KSR*, the Court stated that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.* 127 S. Ct. 1727 (U.S. 2007). The Court noted, “[t]o facilitate review, this analysis should be made explicit.” *See KSR*. It is important to determine whether there was an “apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *See KSR*. Therefore, the Examiner must identify the reason(s) why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. In view of *KSR*, the combination of Zigmond and Doherty is improper.

First, the *proposed combination renders Zigmond inoperable*. *See* Amendment at 20 – 23; MPEP §2143.01. Specifically, the inclusion of Doherty's schedule in Zigmond would force Zigmond to use an ad schedule instead of an on-demand ad-selection process of selecting the ad best suited for insertion at or near the time of insertion. It is impossible to have both a system that utilizes a pre-defined ad schedule and that selects ads on-demand. As such, Doherty's schedule is directly contrary to Zigmond's existing system and would render Zigmond inoperable.

In addition, the *proposed combination also lacks common sense*. Amendment at 21 – 22. Since Zigmond's system already has the ability to select the desired advertisement(s) “on demand”, there is simply no reason to add a schedule of ads to Zigmond's system. One skilled in the art would not add a schedule that includes a priority selection system as taught by Doherty to Zigmond's

system. Due to these conflicting teachings, the combination of the Zigmond and Doherty is not a product of “common sense,” as required by KSR. Furthermore, there is nothing that suggests the desirability of combining these references. Amendment at 21. Merely pointing out the existence of particular teachings in one reference is not sufficient to establish that there would be a motivation to combine that reference with another. *See* MPEP 2144.

Furthermore, *Zigmond Teaches Away from Doherty*. *See* Amendment at 22; Non-Final Office Action at 5. Despite the Examiner’s assertion to the contrary at page 8 of the Final Office Action, Zigmond took into account “a system wherein multiple advertisements are to be displayed”, *but specifically did not follow this concept in his invention*. One skilled in the art would not have found it obvious to add multiple pre-selected advertisements to Zigmond, when Zigmond itself had this knowledge and specifically chose a system that is directed to “selecting a single advertisement” at the instant of insertion – not multiple ads from an ordered list or queue.

Applicants also respectfully submit that in selectively considering the ad selection, the Examiner has seemingly ignored instructions that “[t]he references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination,” (see MPEP 2141). *See* Amendment at 22 – 23; MPEP 2141.02.

Accordingly, Applicants respectfully submit that the combination of Zigmond and Doherty is improper. Even if properly combinable, which they are not, all features of the claims would still not be taught by the combination. Therefore, the Examiner has not met the burden of *prima facie* obviousness. Accordingly, for the reasons detailed herein as well as in Applicants’ Amendment and RCE, independent claims 1, 60, 79 and 97, and all claims dependent thereon, are allowable over the combination of Zigmond and Doherty and/or Bhagavath.

Applicants respectfully submit that the Examiner's rejections have been previously overcome, and that the application, including claims 1 – 10, 12 – 18, 60, 62 – 65 and 68 – 105, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.